

## **REMARKS**

### **I. Introduction**

Claims 9 to 14, 17, and 18 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claim 13 Under 35 U.S.C. § 112, Second Paragraph**

Claim 13 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. It is respectfully submitted that claim 13 is definite for at least the following reasons.

As shown in the Figure, the graphite particles 14 may be arranged in the plane of the Ag layer 12 such that the particles 14 exhibit different properties along different axes, i.e., anisotropically. For example, the particles 14 may have different length, width, and thickness dimensions within the plane of the Ag layer 12. (Specification, p. 5, lines 1 to 9). Thus, it is respectfully submitted that one having ordinary skill in the art would understand the feature of claim 13 of the graphite particles 14 being arranged either anisotropically or statistically along a habitus plane of the Ag layer 12.

Accordingly, it is respectfully submitted that the present claims sufficiently “set forth and circumscribe a particular subject matter with a reasonable degree of clarity and precision,” which is all that is required under 35 U.S.C. § 112, second paragraph.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 9 to 14, and 18 Under 35 U.S.C. § 102(b)**

Claims 9 to 14, and 18 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,199,553 (“Shinohara et al.”). It is respectfully submitted that Shinohara et al. do not anticipate the present claims for at least the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in

the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Claim 9 relates to a contact surface for an electrical contact, including, *inter alia*, an Ag layer galvanically deposited on a copper-based substrate, the Ag layer including finely dispersed graphite particles, in which *each of the graphite particles does not simultaneously include a maximum thickness and a maximum width*.

Shinohara et al. do not identically disclose, or even suggest, all of the claimed features of claim 9. Shinohara et al. merely indicate an Ag coating layer that includes graphite particles of various sizes. In this regard, Shinohara et al. merely mention graphite particles having varying long and short diameter dimensions. Col. 15, lines 6 to 8, and 12 to 14; and col. 18, lines 41 to 43, and 58 to 60. Further, Shinohara et al. states at col. 19, lines 62 to 63 that “the particle size of C must be determined on the basis of all the factors.” Indeed, the Office Action of January 11, 2008 admits at page 5 that “[t]he particles of the graphite powder [of Shinohara et al.] appear to have random length, thickness and width.” Thus, nowhere do Shinohara et al. even mention that each of the graphite particles does not simultaneously include both a maximum thickness and a maximum width. Indeed, by having random length, thickness and width, it is likely that some of the graphite particles of Shinohara et al. include both a maximum thickness and a maximum width. Therefore, Shinohara et al. do not identically disclose, or even suggest, the feature in which *each of the graphite particles does not simultaneously include a maximum thickness and a maximum width*.

Accordingly, Shinohara et al. do not identically disclose, or even suggest, all of the features included in claim 9. As such, it is respectfully submitted that Shinohara et al. do not anticipate claim 9.

As for claims 10 to 14, and 18, which depend from and therefore include all of the features included in claim 9, it is respectfully submitted that Shinohara et al. do not anticipate these dependent claims for at least the same reasons more fully set forth above.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Rejection of Claim 17 Under 35 U.S.C. § 103(a)**

Claim 17 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Shinohara et al. and U.S. Patent No. 5,967,860 (“Ricketts et al.”). It is respectfully submitted that the combination of Shinohara et al. and Ricketts et al. does not render unpatentable the presently pending claims for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

Claim 17 includes features analogous to claim 9. As more fully set forth above, Shinohara et al. do not disclose, or even suggest, the feature in which *each of the graphite particles does not simultaneously include a maximum thickness and a maximum width*. Ricketts et al. also do not disclose, or even suggest, this feature, and thus, fail to cure this critical deficiency.

Accordingly, it is respectfully submitted that the combination of Shinohara et al. and Ricketts et al. does not disclose, or even suggest, all of the features included in claim 17. As such, it is respectfully submitted that the combination of Shinohara et al. and Ricketts et al. does not render unpatentable claim 17.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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